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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/839,498 | 04/20/2001 | Patricia Maes | MLB-081 | 2591 |
| 21323 | 7590 | 06/03/2004 | EXAMINER | |
| TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110 | | | FADOK, MARK A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3625 | |

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,498

Applicant(s)

MAES ET AL.

Examiner

Mark Fadok

Art Unit

3625

MFW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26, drawn to a method for facilitating a search using progeny attribute values, classified in class 707, subclass 5.
- II. Claims 27-47, drawn to a system for facilitating a search using progeny attribute values, classified in class 707, subclass 5.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case Group I does not require all the functionality of Group II. Note: at least steps b and c in claim 1 can be done by hand.

This application contains claims directed to the following patentably distinct species of the claimed invention:

If Group I is selected the group will be subject to the following species restriction

Species IA – 1,2,3,4,6,7,8,9,10,15,23,24 (random selection, selecting progeny attribute for measurable attribute, single computer)

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Species IB – 1,2,3,4,6,7,8,9,10,14,23,24 (random selection, random probability function, single computer)

Species IC – 1,2,3,4,6,7,8,9,10,16,17,18,23, 24 (random selection, for a subset of measurable items selecting progeny values, single computer)

Species ID – 1,2,3,4,6,7,8,9,10,19,23, 24 (random selection, associating a fraction for attributes, single computer)

Species IE – 1,2,3,4,6,7,8,9,10,20,21,22,23, 24 (random selection, for a subset single associating a fraction for attributes, single computer)

Species IF – 1,2,3,4,6,7,8,9,10,15,25,26 (random selection, selecting progeny attribute for measurable attribute, multiple computer)

Species IG – 1,2,3,4,6,7,8,9,10,14, 25,26 (random selection, random probability function, multiple computer)

Species IH – 1,2,3,4,6,7,8,9,10,16,17,18, 25,26 (random selection, for a subset of measurable items selecting progeny values, multiple computer)

Species IJ – 1,2,3,4,6,7,8,9,10,19, 25,26 (random selection, associating a fraction for attributes, multiple computer)

Species IK – 1,2,3,4,6,7,8,9,10,20,21,22, 25,26 (random selection, for a subset single associating a fraction for attributes, multiple computer)

Species IL – 1,2,3,4,6,7,8,9,10,11,12,13,25,26 (random selection, proximity of candidate product, multiple computer)

Species IM – 1,2,3,5,6,7,8,9,10,15,23, 24 (distributed sample, selecting progeny attribute for measurable attribute, single computer)

Species IN – 1,2,3,5,6,7,8,9,10,14,23, 24 (distributed sample, random probability function, single computer)

Species IO – 1,2,3,5,6,7,8,9,10,16,17,18,23, 24 (distributed sample, for a subset of measurable items selecting progeny values, single computer)

Species IP – 1,2,3,5,6,7,8,9,10,19,23, 24 (distributed sample, associating a fraction for attributes, single computer)

Species IQ – 1,2,3,5,6,7,8,9,10,20,21,22,23, 24 (distributed sample, for a subset single associating a fraction for attributes, single computer)

Species IR – 1,2,3,5,6,7,8,9,10,15, 25,26 (distributed sample, selecting progeny attribute for measurable attribute, multiple computer)

Species IS – 1,2,3,5,6,7,8,9,10,14, 25,26 (distributed sample, random probability function, multiple computer)

Species IT – 1,2,3,5,6,7,8,9,10,16,17,18, 25,26 (distributed sample, for a subset of measurable items selecting progeny values, multiple computer)

Species IU – 1,2,3,5,6,7,8,9,10,19, 25,26 (distributed sample, associating a fraction for attributes, multiple computer)

Species IV – 1,2,3,5,6,7,8,9,10,20,21,22, 25,26 (distributed sample, for a subset single associating a fraction for attributes, multiple computer)

Species IW – 1,2,3,4,6,7,8,9,10,11,12,13,25,26 (distributed sample, proximity of candidate product, multiple computer)

If Group II is selected the group will be subject to the following species restriction.

Species IIA –27,28,29,30,31,32,33,34,35,44,45 (random probability function, single computer)

Species IIB –27,28,29,30,31,32,33,34,36,44,45 (attribute values as progeny values, single computer)

Species IIC –27,28,29,30,31,32,33,34,37,38,39,44,45 (subset makes up progeny values, single computer)

Species IID –27,28,29,30,31,32,33,34,40,44,45 (associated with fractional value, single computer)

Species IIE –27,28,29,30,31,32,33,34,41,42,43,44,45 (for each of a subset of values associating it with a fractional value, single computer)

Species IIF –27,28,29,30,31,32,33,34,35,46,47 (random probability function, multiple computer)

Species IIG –27,28,29,30,31,32,33,34,36,46,47 (attribute values as progeny values, multiple computer)

Species IIH –27,28,29,30,31,32,33,34,37,38,39,46,47 (subset makes up progeny values, multiple computer)

Species IIJ –27,28,29,30,31,32,33,34,40,46,47 (associated with fractional value, multiple computer)

Species IIK –27,28,29,30,31,32,33,34,41,42,43,46,47 (for each of a subset of values associating it with a fractional value, multiple computer)

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1 and 27 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a long horizontal flourish extending to the right.

Mark Fadok

Patent Examiner